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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,034

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EXAMINER

COLE, ELIZABETH M

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/523,034	Applicant(s) HOJO ET AL.	
	Examiner Elizabeth M. Cole	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-9,11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-9,11,13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 4, 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 4, it is not clear what pores are being referred to, no material having pores is recited in any of the independent claims. Does this refer to pores between the particles or within the particles, (i.e., interparticle pores or intraparticle pores?). The same problems are present in claims 7-9.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6, 11, 13 are rejected under 35 U.S.C. 103(a) as obvious over Welshimer et al, U.S. Patent Application Publication 2001/0042494 in view of Wertz et al, U.S. Patent No. 6,936,681. Welshimer et al discloses a granulate material which can comprise inorganic compounds such as silica, calcium carbonate and zeolite, (see paragraph 0013 and 0023) and a binder which can comprise materials such as amino acids, (see paragraph 0025), in amounts of 2-20 weight percent, (see paragraph 0025). Welshimer does not disclose the BET specific surface area or that the composition satisfies the equations set forth in the claims, however, since Welshimer discloses the same materials in the same amounts, it is reasonable to presume that the compositions of Welshimer would satisfy the equations set forth in the claims. When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which

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anticipate or render obvious the claimed invention the examiner has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP §§ 2112- 2112.02. Further, since as set forth below, Wertz teaches providing particles having the claimed size, it is reasonable to expect that once the particles in the size taught by Wertz are provided, they would have the claimed properties.

4. With regard to the limitation that the composition is a flower thinning agent, since this statement is a statement of intended use and since the composition of Welshimer is capable of performing this intended use since it is the same composition, Welshimer meets this limitation. Further, it is noted that this limitation appears in the preamble of the claim. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

5. Welshimer differs from the claimed invention because it does not teach the claimed particle size. Wertz discloses a particulate fertilizer. Wertz teaches that the size of the particles can be controlled depending upon the use of the fertilizer and that when the fertilizer is used to fertilize seeds that a very small particle size of 10-80 microns can be used. See col. 5, lines 39-64. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have formed the

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particles of Welshimer so that they had a smaller size as taught by Wertz in order to allow the fertilizer granules of Welshimer to better fertilize and adhere to seeds.

6. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welshimer in view of Wertz et al, U.S. Patent No. 6,936,681.as applied to claims above, and further in view of Walker, U.S. Patent No. 6,110,866. Welshimer discloses a granulate mixture suitable for use as a fertilizer and/or pesticide. Welshimer does not disclose incorporating calcium phosphate into the mixture. Walker teaches at col. 3, lines 5-19 that suitable inorganic materials for forming fertilizers and carriers for fertilizers, pesticides, etc., include both limestone, (calcium carbonate as taught by Welshimer) as well as calcium phosphate. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have employed calcium phosphate instead of calcium carbonate in view of their art recognized equivalence for this purpose.

7. Applicant's arguments filed 1/21/09 have been fully considered but they are not persuasive. With regard to the 112 2nd paragraph rejection, Applicant argues that the recitation of Dxs refers to pores in the flower thinning agent and that the pores are defined in the claim and that the nature of the pores is irrelevant. However, there is no definition of the pores in the claims. The claims do not define which materials have the pores or where the pores are located. Without even known where the pores are located, claims are vague and indefinite. . There is a difference between a non porous particle which has pores between particles and a porous particle with pores also

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between the particles or a porous particle with no pores between particles. The claimed structure must be defined in the claim.

8. Applicant argues that the Welshimer and Wertz references cannot be combined because Wertz only generally states that the particles size is dictated by the specific application for which the particle is to be used. However, Wertz teaches using the very small particles to allow for better fertilization and to adhere to seeds. Applicant argues that Welshimer does not teach treating seed but instead discloses a carrier for chemical agents such as herbicides and pesticides. However, Welshimer also teaches a carrier material for various chemical compounds that are used in horticulture. Therefore, the teachings of Wertz with regard to particle size would be pertinent to the person of ordinary skill in the art when considering the Welshimer reference.

9. Applicant argues that Welshimer teaches forming the material into pellets not into the claimed particle size and since Welshimer does not teach the claimed particle size it teaches away from the smaller particle size of Welshimer. However, Welshimer contains no teaching away from making the particles smaller. Further, Wertz provides a positive teaching regarding benefits of using smaller particles sizes. Therefore, it would have been obvious to have made the particles of Welshimer smaller.

10. Applicant argues that the two references are drawn to different materials and therefore there is no general motivation for combining them. However, both references refer to granular agents for use in horticulture and Wertz teaches using extremely small particles allows for better treatments of seeds and therefore provides to combine the references.

11. With regard to KSR, the citation in the previous action stated that arguments that there is no teaching, suggestion or motivation have been foreclosed by KSR. The references do not need to provide a specific teaching, suggestion or motivation to combine, therefore the argument that the references do not contain such a teaching, suggestion or motivation has been foreclosed by KSR>

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

The examiner's supervisor Rena Dye may be reached at (571) 272-3186.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794

e.m.c